

## REMARKS

The Response is submitted in response to the final Office Action dated July 19, 2005. Claims 1-4, 6, 10-29 and 32-37 are pending in this application. In the Office Action, Claims 1-4, 6, 10-29 and 32-36 are rejected under 35 U.S.C. §103(a). In response set forth below, Applicants respectfully submit that the Patent Office should withdraw these rejections.

In the Office Action, Claims 1-4, 6, 10-17, 21-24 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,285,041 to Wright ("*Wright*"), in view of U.S. Patent No. 5,936,527 to Isaacman et al. ("*Isaacman*") and U.S. Patent 5,353,692 to Reese et al. ("*Reese*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

Claims 1, 12, 13, 21 and 35 recite, in part, delivering a beverage-forming product and a dispenser configured to prepare and dispense a beverage product. A programmable tag is associated with the beverage-forming product wherein the programmable tag contains coded information relevant to the preparation of the beverage or configuring the dispenser for preparation of the beverage.

Applicant respectfully submits that because the cited references are directed towards completely unrelated inventions with different objectives, one skilled in the art would not be motivated to modify or combine them to arrive at the present claims. In fact, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

For example, while *Wright* is directed to an automated food vending system for solid foods such as pizza, frozen fries, etc., and *Reese* is directed to a hot beverage brewing apparatus, *Isaacman* is directed to a method and apparatus for locating and tracking documents. Though *Isaacman* does disclose the use of a Radio Frequency Identification Tag (RFID), it does so in relation to automatically locating and tracking movable objects, particularly files or similar documents typically housed on shelves, drawers, filing cabinets or warehouses, which teaches away from *Wright* and *Isaacman*. See, *Isaacman*, column 4, lines 45-53. *Isaacman* does not deal with RFIDs as readable storage for preparation of beverages or configuration of a dispenser

used for the preparation of beverages. Consequently, the Patent Office has improperly applied hindsight to combine *Wright* and *Reese* with *Isaacman* to arrive at the present claims.

Applicants also submit that, even if combinable, the cited references fail to disclose or suggest all of the elements of the present claims. For example, *Wright* and *Reese* fail to disclose or suggest a programmable tag associated with the beverage-forming product, let alone a programmable tag that comprises preparation instructions or data relevant for configuring the dispenser as to the preparation of the beverage as required, in part, by the present claims. The Patent Office states the same regarding *Wright*. See, Office Action, page 3, lines 1-3. Similarly, *Reese* fails to disclose or suggest anywhere the use of programmable tags as readable storage for this information. *Isaacman*, though disclosing the use of RFIDs, fails to disclose or suggest programmable tags that contains information relevant to preparation of the beverage of configuring the dispenser as to the preparation of the beverage. As discussed previously, *Isaacman* discloses an RFID specifically for automatically locating and tracking movable objects, particularly files or similar documents typically housed on shelves, drawers, filing cabinets or warehouses. See, *Isaacman*, column 4, lines 45-53.

For the reasons discussed above, the combination of *Wright* in view of *Isaacman* and *Reese* is improper. Moreover, even if combinable, *Wright*, *Isaacman* and *Reese* do not teach, suggest, or even disclose all of the elements of the present claims, and thus, fail to render the claimed subject matter obvious for at least these reasons.

Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 1-4, 6, 10-17, 21-24 and 32-36 be reconsidered and rejection be withdrawn.

In the Office Action, Claims 18-20 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wright* as modified by *Isaacman* and *Reese* as applied to Claims 1-17 above, and further in view of US Patent No. 5,285,041 to Buckley et al. ("*Buckley*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below. Applicants note that Claims 18-20 were previously canceled.

Applicants respectfully submit that there is no motivation to combine the cited references to arrive at the present claims. As discussed previously, while *Wright* is directed to an automated food vending system and *Reese* is directed to a hot beverage brewing apparatus, *Isaacman* is directed to a method and apparatus for locating and tracking documents. *Buckley* is directed vending personalized products, particularly personalized greeting cards. While *Wright* and

*Reese* of the cited references are arguably directed to food technologies, *Buckley* and *Isaacman* are directed to completely different fields of invention.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01. As discussed previously, the cited references clearly do not suggest the desirability of the alleged combinations. In fact, to support the combination and/or modification of the cited art, the Patent Office has improperly applied hindsight reasoning by selectively piecing together teachings of each of the references in an attempt to recreate what the present claims disclose. Indeed, Applicant respectfully submits that it is only with a hindsight reconstruction of Applicant's present claims that the Patent Office is able to even attempt to piece together a rejection of the claims. Of course, the Court of Appeals for the Federal Circuit has criticized this motivation to combine analysis (e.g., hindsight reconstruction) because the motivation to combine the references was first disclosed in the present invention. *In re O'Farrell*, 853 F.2d, 894, 902-903 (Fed. Cir. 1988).

In regards to Claims 25-29, Applicants submit that cited references fail to disclose or suggest all of the elements of the present claims. As discussed previously, the combination of *Wright*, *Isaacman* and *Reese* fail to disclose or suggest a programmable tag that contains information relevant to the preparation of the beverage or configuring the dispenser as to the preparation of the beverage as required, in part, by the present claims. Furthermore, *Buckley* fails to remedy this deficiency because the Patent Office uses *Buckley* in relation to Applicants' dependent Claims 25-29, rather than the programmable tag element in independent Claim 21, for which claims 25-29 depend. Regardless, *Buckley* also fails to disclose a programmable tag that contains information relevant to the preparation of the beverage or configuring the dispenser as to the preparation of the beverage. In fact, *Buckley* (1) makes no mention of any programmable tag that would be affixed on packaged components and (2) lacks any interactivity between a programmable tag on a product and the vending system.

For the reasons discussed above, the cited references do not teach, suggest, or even disclose all the elements of the present claims and thus, fail to render the claimed subject matter obvious for at least these reasons. Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 18-20 and 25-29 be reconsidered and rejection be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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